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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/773,925
Filing Date: February 06, 2004
Appellant(s): PIERPONT ET AL.

Timothy J. Zarley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/28/08 appealing from the Office action mailed 6/30/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5484412	PIERPONT	1-1996
4988356	CRITTENDEN	1-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierpont (USPN 5,484,412) in view of Crittenden et al (USPN 4,988,356). Regarding claims 1 and 5-10, Pierpont discloses an elongated hollow anchoring catheter 22; a hollow guiding catheter 41; first, second and third balloons with independent inflation; a treatment catheter 18; a guidewire 16; and blood by-pass means (claim 5). See figures 1-5. The treatment catheter is movably positioned in the anchoring catheter (abstract). The anchoring catheter includes balloons 30 which project inwardly to secure the treatment catheter. See Fig. 5. An anchoring balloon 38 attached to the outer surface of the tubular wall of the anchoring catheter engages blood vessel 14. See Fig. 5. Pierpont fails to disclose that the treatment catheter extends through an opening in the tubular wall of the anchoring catheter

Crittenden teaches a catheter and guidewire exchange system that includes the teaching of introducing an elongated element (guidewire) through a side slit opening in a catheter. The catheter further includes a guide member that slides along the length of the catheter in order to facilitate opening and re-sealing of the slit. See figures 1 and 10.

At the time of the invention, it would have been obvious to incorporate the teaching of using a side slit opening into the invention of Pierpont and specifically into the tubular wall of the anchoring catheter. Side slit openings are well known in the art and are used in order to

enable the medical technician to introduce and remove additional devices into and out of indwelling catheters. The advantages are well known in the art and result in improved ease of use and safety to the patient. One skilled in the art would have used these known motivations to incorporate the slit and guide member of Crittenden into the invention of Pierpont.

(10) Response to Argument

Applicant's arguments submitted in the Appeal Brief filed 8/28/08 have been fully considered and are not persuasive.

Applicant argues that the combination of the prior art references would not result in the invention as claimed. Applicant argues that there is no teaching of an elongated treatment catheter extending through an opening in the tubular wall of an anchoring catheter. The examiner disagrees. Pierpont teaches the invention, including a hollow guiding catheter 41, an anchoring catheter 22 and a treatment catheter 18 extending through the anchoring catheter. In contrast to the instant application, the treatment catheter of Pierpont extends through the proximal end of the anchoring catheter instead of through a sidewall. However, the examiner contends that this is a known concept. It is known in the art to extend one member through a slit in the sidewall of another member. The examiner relies upon Crittenden to teach that this is a well known concept. Crittenden teaches that a guidewire may be inserted through the sidewall of a catheter instead of through the proximal end to allow for easy removal of one from the other. In other words, Crittenden is relied upon to teach the general concept that an elongate member may be inserted through the sidewall of a catheter instead of through the opening at the proximal end. Given this teaching, one of skill in the art would know that it would be obvious to extend any elongate member, whether it be a guidewire, a lead, a catheter, etc. through the sidewall of

another elongate member in which the first elongate member will reside. This configuration has many benefits including allowing for better control of the two members relative to each other and allowing for easy removal of the inner member from the outer member.

While the examiner agrees with applicant that Crittenden does not *specifically* teach extending a treatment catheter through the sidewall of an anchoring catheter, the examiner does not believe that this renders the rejection improper. All of the elements, i.e. the anchoring catheter, guiding catheter, treatment catheter, are taught by Pierpont, and the general concept of inserting one member through the sidewall of another is taught by Crittenden. Therefore, the examiner believes that the rejection is proper and renders the claimed invention obvious.

Applicant argues that the combination of Pierpont and Crittenden relied upon hindsight reasoning. The examiner disagrees. The test for making a combination to teach obviousness is given both of the references, would one of skill in the art know to reasonably make the combination. The examiner believes that this is the case. First, in this case the analogous art or the areas in which one would reasonably look to find applicant's invention include catheters having balloons and catheters having elongate elements extending within the lumen. Both Pierpont and Crittenden fall within these arts. It is reasonable to expect that when searching for a device that is concerned with advancing a balloon dilation treatment catheter (as applicant correctly characterizes Pierpont) one would look to devices concerned with advancing guidewires through catheter. This is especially true in the catheter arts where there are many known variations that can be found in numerous different categories of catheters.

Applicant points out that the inventor of the instant application, as well as the inventor of the base reference in the instant rejection, Dr. Pierpont, was aware of the work of the inventor of

the teaching reference, Dr. Crittenden, and at the time Dr. Pierpont did not contemplate using Dr. Crittenden's teachings. Applicant admits that Pierpont contemplated using these teachings years later, resulting in the instant application. The examiner does not find this argument convincing. The bottom line is that these two teachings were available to the inventor at the time of invention, and the fact that it did not occur to the inventor to make the combination until a later time does not support the assertion that the combination would not have been obvious.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Laura A Bouchelle/

Examiner, Art Unit 3763

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